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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/756,427      | 01/08/2001  | Koichi Hayakawa      | 112857-247          | 5517             |

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EXAMINER

SMITH, TRACI L

ART UNIT PAPER NUMBER

3629

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/756,427

Applicant(s)

HAYAKAWA, KOICHI

Examiner

Traci L. Smith

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08/10/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-8, 10-16,18-20 and 22- 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8, 10-16,18-20 and 22- 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

This action is in response to papers filed on August 10, 2006.

Claims 1, 3-5, 7, 14-16, 18, 22,24-25 have been amended.

Claims 2, 9, 17 and 21 have been cancelled.

Claims 1,3-8, 10-16,18-20 and 22- 25\_are pending.

Claims 1,3-8, 10-16,18-20 and 22- 25 are rejected.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1,3-8, 10-16,18-20 and 22- 25 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

3. Claims 1,3-8, 10-16,18-20 and 22- 25 fail to describe the below limitations so that one of ordinary skill in the art can make and/or use applicants invention without undue experimentation.

- a. How does the communication manager detect the connection or disconnection to a network.

- b. How does a software installing means "identify" a software module?

- c. What/where is the electronic device sending or receiving message?
  - d. What triggers the messages to be sent?
  - e. How does the system know to install or uninstall software?
4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 1,3-8, 10-16,18-20 and 22- 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. As to claims 1,3-8, 10-16,18-20 and 22- 25 the limitation of software installing fails to clearly point out what function this module is performing. Is the module identifying an electronic device, information processing apparatus or a communication manager.
7. Regarding claims 1, 8 14, 15 and 20 the word "means" is not preceded by the word(s) needed to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). The applicant fails to claim any function the structure is performing.

\*\*\*\*\*The examiner notes the above rejection with prior art is applied below as the invention is best understood by the examiner.\*\*\*\*\*

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action

A person shall be entitled to a patent unless –

9. (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

10. Claims 1,3-8, 12-16,18-20 and 22- 25 are rejected under 35 U.S.C. 102(e) as being anticipated by US 20010053980 A1 Suliman JR, et al; Method and System for Blind Electronic Warranty Registration. Hereinafter referred to as Suliman.

11. As to claims 1, 14-16 and 24-25 Suliman teaches.

Communication management that controls information transmission between several apparatus's. (Pg. 2 ¶ 12 & 14),.

Software acquiring when detected connection to network(Pg. 5 ¶48).

Software installation/idenifitying that communicates between device and third party device(Pg. 5 ¶ 54 &61),

Updated product information that is sent to and from device and apparatus(Pg. 8 ¶76).

As to claims 3 and 8 Suliman teaches the process over a network (fig. 1). The fact that they type of connection to a network is not explicitly disclosed to does not distinguish the instant application over the prior art as they steps of the invention steps and outcomes are same regardless of the tyep of connection.

As to claims 4 Suliman teaches production information storage(Pg. 3 ¶ 29).

As to claims 5 and 19 Suliman teaches a device identification storage unit(Pg. 5 ¶56-56).

As to claims 6-7 and 20 Suliman teaches reading and displaying product history informatio(Pg 7 ¶¶69; Pg 8 ¶ 78 PG 4 ¶ 44).

As to claim 8 Suliman teaches the ability to update product history information from third parties(Pg. 8 ¶ 78).

As to claims 12 and 22 Suliman teaches purchase information(Pg. 6 ¶ 60).

As to claims 13 and 23 Suliman teaches repair information(Pg. 8 ¶ 78)

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 3629

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 20010053980 A1 Suliman JR, et al; Method and System for Blind Electronic Warranty Registration.

16. As to claims 10-11 Suliman teaches a system and method for reading/writing and storing information regarding repair and purchase of a product. However, Suliman fails to teach the limitation of not writing over purchase/product information that has already been written. It would have been obvious to one of ordinary skill in the art at the time of invention to combine Suliman with this limitation. Sulimans method is used to share product life cycle information with second hand buyers it would be necessary/important for the second buyer to know when the device was purchsd and all the type of information regarding the device to determine if the device was worth the value being requested.

### **Response to Arguments**

As to applicants arguments filed on August 10, 2006 applicants arguments are moot in view new rejections.

***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

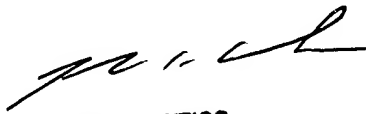
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TLS



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